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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/615,749 | 07/08/2003 | Donald F. Swanson | 8491-50 | 9885 |
| 7590 | 03/29/2004 | | EXAMINER | |
| Eun-Young Choi Davis Wright Tremaine 1501 Fourth Avenue Seattle, WA 98101 | | | WILKENS, JANET MARIE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3637 | |

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------------|--------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/615,749 | SWANSON, DONALD F. |
| | Examiner Janet M. Wilkens | Art Unit 3637 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 July 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 34-45 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 34-45 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 08 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: nowhere in the specification is "evening off" of the building materials discussed.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

(Namely, it is improper to have the phrase "the present invention" in the abstract.)

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the building materials (strapped and unstrapped) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (3,848,747). Thompson teaches a portable rack/pallet (12) comprising: a base having a proximal beam (14), a distal beam (14), crossbars (15), and means (50) for lifting the pallet with the forks of a forklift, and a plurality of elongated members (18) attached to the proximal and distal sides of the pallet and projecting upwardly from the base. Although no detailed process of stacking building materials, such as is found in claims 34-45, is stated in Thompson (Note: it is stated that material can be installed on the pallet in the direction of arrow A shown in Fig. 1), this process could inherently be met using an "un-stacked" pallet (12 or 13) of Thompson; the process itself being an obvious method of placing and stacking material on the pallet and moving the pallet to and from. The intended use of the pallet of Thompson being the determining factor as to whether or not to employ this type of process. For example, if elongated items, such as wood, etc. are placed on the pallet, some of these items could be positioned so as to abut at least two of the elongated members of Thompson. The items could also be positioned on the pallet from either the distal or proximal side and/or strapped together, if desired.

Claims 34-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomsen (6,119,604). Thomsen teaches a portable rack/pallet (Fig. 3) comprising: a base having a proximal beam (one end beam 2), a distal beam (the other end beam 2), crossbars (3), and a plurality of elongated members (5) attached to the proximal and distal sides of the pallet and projecting upwardly from the base. Although the exact process of stacking building materials, such as is found in claims 34-45, is not stated in Thomsen, this process could inherently be met using an "un-stacked" pallet of Thomsen; the process itself being an obvious method of placing and stacking material on the pallet and moving the pallet to and from. The intended use of the pallet of Thomsen being the determining factor as to whether or not to employ this type of process. For example, if elongated items, such as trees, wood, etc. are placed on the pallet, some of these items could be positioned so as to abut at least two of the elongated members of Thomsen. The items could also be positioned on the pallet from either the distal or proximal side and /or strapped together, if desired. See loading/unloading discussion of the pallet of Thomsen starting column 3, line 36 and ending column 4, line 13 wherein abutment of the trees against at least two elongated members is stated and the "first loaded, last unload" feature is also discussed.

Response to Arguments

Addressing the arguments concerning the process claims: as stated above in the art rejection, the examiner contends that the processes of loading materials on a pallet via a forklift, manually, etc, having the materials rest against elongated members

extending up from the pallet (manually or via equipment placing them there), placing the materials in last-in, first out order, etc. are well known/common practices in the art. Furthermore, the fact that Thompson states one way of loading his pallet does not in and of itself preclude other methods of loading materials on the pallet. The disclosed pallet and Thompson's pallet are structurally the same; loads could be placed thereon in similar manners. Therefore, even though the reference of Thompson fails to specifically teach the claimed processes and rather teaches that materials are placed on the pallet from the side thereof, one of ordinary skill in the art using the pallet of Thompson would have been quite aware of such alternate processes/methods and could have utilized them if and when desired. This same reasoning would also apply to the reference of Thomsen.

Addressing the declaration filed May 7, 2002: for objective evidence to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention. A *prima facie* case of nexus is generally made out when the patentee shows both that there is commercial success and that the product or method that is commercially successful is the invention disclosed and claimed in the patent. *In re GPAC Inc., supra*, 57 F.3d at 1580. The process claims as presently amended have been altered and are now substantially broader (the amendments stemming from previously drawing objections). It would appear that since the fork lift limitations have been deleted from the claims, that the process described in the claims would now not be the same process used to compile the information of the declaration.

This is a continuation of applicant's earlier Application No. 10/140,970. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet M. Wilkens whose telephone number is (703) 308-2204. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (703) 308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wilkens
March 17, 2004

J.M. Wilkens
JANET M. WILKENS
PRIMARY EXAMINER
Art Unit 3637